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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/683,353

12/18/2001

Victor I. Deonarine

ITW7510.008

3939

33647

7590

06/22/2004

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EXAMINER

JAGAN, MIRELLYS

ART UNIT

PAPER NUMBER

2859

DATE MAILED: 06/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/683,353	Applicant(s) DEONARINE, VICTOR I.	
	Examiner Mirellys Jagan	Art Unit 2859	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 6, 8-20 is/are rejected.
- 7) ☒ Claim(s) 4 and 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/18/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. In view of the Appeal Brief filed on 2/27/04, PROSECUTION IS HEREBY REOPENED. New grounds of rejections are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

### ***Claim Objections***

2. Claims 5 and 11-13 are objected to because of the following informalities:

Claim 5 states that each of the curved ends (56) of the connector includes a pair of curved sections. This is not clear since the claim appears to state that there are three curved sections at each end of the connector, e.g., the curved end and the pair of curved sections. From figures 7, it appears that the connector (18) is a longitudinal member having a pair of curved sections (62) at each end.

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In claim 11, there is lack of antecedent basis in the claim for “second housing elements” in line 3. Claims 12 and 13 are objected to for being dependent on objected base claim 11.

Appropriate correction is required.

*Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 6, 8, 16, and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by the publication titled “OMEGAMARKER<sup>®</sup> Temperature Test Kit” by OMEGA<sup>®</sup> [hereinafter OMEGA<sup>®</sup>].

Referring to claims 1, 6, and 8, OMEGA<sup>®</sup> discloses an assembly comprising:

a first housing positioned along a first axis and configured to hold a compound that melts at a first temperature;

a second housing positioned along a second axis and configured to hold a second compound that melts at a second temperature; and

a one-piece connector (the case) physically connecting the first and second housings along different axes;

wherein the connector is configured to snap-fit the housings to the connector, thereby slidably securing the housings side-by side.

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Referring to claims 16 and 18-20, OMEGA<sup>®</sup> discloses an apparatus comprising:  
first means comprising a first stick for indicating a first temperature;  
second means comprising a second stick for indicating a second temperature; and  
means (the case) for retaining the first means to the second means in a side-by-side relationship to form an assembly capable of indicating at least two temperatures;

wherein the means for retaining the first means to the second means comprises a pair of tubular members (the housings in which each of the sticks are located) secured together by a connector (the case) that includes a longitudinal member (e.g., one side of the casing) having curved ends (the sections that snap-fit the housings to the case) “integrally molded” to each of the tubular members (i.e., shaped so as to snap-fit the housings, as defined by applicant on page 9, paragraph 23, of the specification).

5. Claims 1, 3, 5, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 6,022,159 to Kossnar et al [hereinafter Kossnar].

Kossnar discloses an assembly comprising:

a first housing (32a) positioned along a first axis and configured to hold a compound that melts at a first temperature;

a second housing (32b) positioned along a second axis and configured to hold a second compound that melts at a second temperature; and

a one-piece connector (10) physically connecting the first and second housings along different axes;

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wherein the connector comprises a longitudinal member having curved ends including curved sections that are configured to slidably secure the housings to the connector in a side-by-side relationship (see figure 2).

Furthermore, referring to claim 1, the term “configured to” is not considered to be a positive limitation since it only requires the ability to so perform, i.e., the housings (34) of Kossnar are “configured” to hold a compound that melts at a given temperature since such a compound can be held by the housings, if so desired. It does not constitute a limitation in a patentable sense.

6. Claims 1, 3, 5, 6, 8, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 3,564,668 to Kirk.

Kirk discloses an assembly comprising:

a first housing (pencil) positioned along a first axis and configured to hold a compound that melts at a first temperature;

a second housing (pencil) positioned along a second axis and configured to hold a second compound that melts at a second temperature; and

a one-piece connector physically connecting the first and second housings along different axes;

wherein the connector comprises a clip member (10) configured to permit attachment of the assembly to an object, and a longitudinal member (12) having curved ends (e.g., 13, 18) including curved sections (e.g., 15, 17) that are configured to slidably secure the housings to the

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connector in a side-by-side relationship and configured to snap-fit the housings to the connector (see figures 1 and 3).

Furthermore, referring to claim 1, the term “configured to” is not considered to be a positive limitation since it only requires the ability to so perform, i.e., the pencils of Kirk are “configured” to hold a compound that melts at a given temperature since such a compound can be held in the pencils, if so desired. It does not constitute a limitation in a patentable sense.

7. Claims 1, 3, 5, 6, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,244,660 to Aronson.

Aronson discloses an assembly comprising:

a first housing (pencil) positioned along a first axis and configured to hold a compound that melts at a first temperature;

a second housing (pencil) positioned along a second axis and configured to hold a second compound that melts at a second temperature; and

a one-piece connector (12) physically connecting the first and second housings along different axes;

wherein the connector comprises a longitudinal member having curved ends including curved sections that are configured to slidingly secure the housings to the connector in a side-by-side relationship, and configured to snap-fit the housings to the connector (see figure 1).

Furthermore, referring to claim 1, the term “configured to” is not considered to be a positive limitation since it only requires the ability to so perform, i.e., the pencils of Aronson are

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“configured” to hold a compound that melts at a given temperature since such a compound can be held in the pencils, if so desired. It does not constitute a limitation in a patentable sense.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over OMEGA<sup>®</sup> in view of U.S. Patent 1,603,713 to Peterson.

OMEGA<sup>®</sup> discloses an apparatus comprising all of the limitations of claims 2 and 17, as stated above in paragraph 4, except for the apparatus having means for controlling the movement of the sticks.

Peterson discloses a device for holding a crayon. Peterson teaches a mechanism for controlling the movement of a crayon within a holder. The mechanism comprises a collet (5) having threads for screwing onto the end of the holder. The end of the holder is provided with a plurality of resistance mechanisms (arms) that are pressed together against the crayon by the collet to engage the crayon (which will limit rotational movement). Peterson teaches that it is useful to provide such a mechanism since it allows a user to control the movement of the sticks, i.e., allows a user to extend or retract the crayon a desired distance from or into the holder, in order to store or protect the crayon.



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It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus disclosed by OMEGA<sup>®</sup> by adding means for controlling the movement of the sticks to the housings, as taught by Peterson, in order to allow a user to extend or retract the sticks a desired distance from or into the holders when marking a surface with the sticks.

10. Claims 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over OMEGA<sup>®</sup> in view of Peterson.

OMEGA<sup>®</sup> discloses a holder comprising:

a connector assembly comprising a first housing connected to a second housing, which are capable of holding sticks therein, by a clamp, which aligns the housings along different axes and comprises a longitudinal member having curved ends and slidingly securing the housings in a side-by-side relationship, wherein the housings have grooves thereon.

OMEGA<sup>®</sup> does not disclose the holder having advancement mechanisms configured to extend the sticks from the connector assembly, wherein the advancement mechanisms engage a respective stick upon rotation of the advancement mechanisms; and resistance mechanisms attached to the housings to limit rotational movement of the sticks.

Peterson discloses a device for holding a crayon. Peterson teaches a mechanism for controlling the movement of a crayon within a holder. The mechanism comprises an advancement mechanism (a collet (5)) having threads for screwing onto the end of the holder. The end of the holder is provided with a plurality of resistance mechanisms (arms) that are pressed together against the crayon by the collet to engage the crayon (which will limit rotational

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movement). Peterson teaches that it is useful to provide such a mechanism since it allows a user to control the movement of the sticks, i.e., allows a user to extend or retract the crayon a desired distance from or into the holder, in order to store or protect the crayon.

Referring to claim 10, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus disclosed by OMEGA<sup>®</sup> by adding means for controlling the movement of the sticks relative to the housings of the connector assembly, as taught by Peterson, in order to allow a user to extend or retract the sticks a desired distance from or into the holders when marking a surface with the sticks.

Referring to claim 13, the housings of OMEGA<sup>®</sup> have a groove thereon. Therefore, the recitation that the grooves are for engaging the end of a clamp to prevent rotational movement is considered to be a recitation of the intended use of the grooves and has not been given patentable weight since a clamp is not positively claimed in claim 13 or any of its intervening claims, and since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. See *Ex parte Masham*, 2 USPQ2d 1647 (1987).

#### ***Allowable Subject Matter***

11. Claims 4 and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. The following is a statement of reasons for the indication of allowable subject matter:

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The prior art of record does not disclose or suggest the following in combination with the remaining limitations of the claims:

A dual temperature indicator stick assembly comprising curved ends having hooks configured to engage the first and second housings to prevent rotation of the housings (see dependent claim 4).

### ***Response to Arguments***

13. Applicant's arguments filed 2/27/04 with respect to the rejection of claims 1, 6, and 16 over OMEGA<sup>®</sup> have been fully considered but they are not persuasive.

Applicant's arguments that OMEGA<sup>®</sup> does not anticipate claim 1 because OMEGA<sup>®</sup> "does not form a dual temperature indicator stick", see page 4, are not persuasive since claim 1 does not claim a dual temperature indicator stick. Furthermore, Applicant argues that OMEGA<sup>®</sup> does not disclose a dual temperature indicator stick assembly because OMEGA<sup>®</sup> discloses an assembly that can have more than two temperature sensitive crayons. These arguments are not persuasive since the recitation "dual temperature indicator stick assembly" has not been given patentable weight because the recitation only occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In this case, OMEGA<sup>®</sup> discloses an assembly having all of the claimed limitations of claim 1, as stated above in paragraph 4. Furthermore, the fact that

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OMEGA<sup>®</sup> shows that the assembly is capable of having more than two crayons does not preclude the assembly from having only two.

Applicant's arguments that OMEGA<sup>®</sup> does not anticipate claim 1 because the "case" of OMEGA<sup>®</sup> is not a "connector" are not persuasive. According to Webster's Dictionary, 10<sup>th</sup> ed. "connect" is defined as "to join or fasten together usually by something intervening". Therefore, the casing of OMEGA<sup>®</sup> is, by definition, is also a "connector" since it connects together the holders of the test kit.

Applicant's arguments that OMEGA<sup>®</sup> fails to disclose a "dual temperature indicator stick assembly, as called for in claim 1", because "the indicator sticks [are] removably contained within the case" and are therefore "not positioned for use in such a position" are not persuasive since the manner in which the assembly is to be used is not a structural limitation of the assembly claimed in claim 1. Furthermore, the recitation "dual temperature indicator stick assembly" has not been given patentable weight because the recitation only occurs in the preamble, as stated above.

Applicant's arguments that the assembly of OMEGA<sup>®</sup> fails to disclose a "dual temperature indicator stick assembly", as called for in claim 1, because the crayons of OMEGA<sup>®</sup> must each be removed from the assembly in order to be used to indicate temperature, and therefore the assembly of OMEGA<sup>®</sup> does not indicate temperature as not persuasive since the manner in which the assembly is to be used is not a structural limitation of the assembly claimed in claim 1. Furthermore, the argument that "it is not the assembly [of OMEGA<sup>®</sup>] that indicated any temperature, but merely the individual temperature-sensitive crayons", as stated in page 8, is

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not persuasive since applicant's assembly also does not indicate temperature: the temperature-sensitive crayons in applicant's assembly indicated the temperature.

Applicant's arguments that OMEGA<sup>®</sup> fails to disclose a connector that slidably secures the housings, as called for in claim 6, because the housings of OMEGA<sup>®</sup> are secured in respective channels are not persuasive since the housings are frictionally held in the 'channels', and therefore can be slidably moved by applying an axial force at either end of the housing. Furthermore, once the crayons wear down because of extensive use, there will be additional space for the housing to slide. OMEGA<sup>®</sup> does not disclose the housing and crayon being in full contact at both ends with the 'channels', and therefore, does not preclude the housings from sliding, even if only slightly. Furthermore, there are not latching mechanisms in OMEGA<sup>®</sup> that lock the housings in place so as not to slide. Therefore, OMEGA<sup>®</sup> does not preclude the housings from being slidable.

Applicant's arguments that OMEGA<sup>®</sup> fails to disclose an assembly capable of indicating at least two temperature, as called for in claim 16, are not persuasive since the manner in which the assembly is to be used is not a structural limitation of the assembly claimed in claim 1.

14. Applicant's arguments with respect to claims 2, 4-7, 9, and 10-15 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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The following patents and publication disclose holders for marking implements:

U.S. Patent 2,656,605 to Schlieder

U.S. Patent 1,983,728 to Bafetti

U.S. Patent 4,415,092 to Boyer

U.S. Patent Des. 389,517 to Frank

U.S. Patent 2,785,654 to Lundberg, Sr., et al

U.S. Patent 6,290,413 to Wang

U.S. Patent Application Publication 2002/0032069 to Arrison

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mirellys Jagan whose telephone number is 571-272-2247. The examiner can normally be reached on Monday-Friday from 9AM to 4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez can be reached on 571-272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJ  
June 17, 2004

  
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